

Remarks/Arguments:

The drawing was objected with regard to Figure 2. It is clear from the surrounding text that the block 230 "DTMF DECODE" was in error and is amended to "DTMF DECODER" to correct this error.

Claims 1-18 are pending in the above identified application.

Claim 1 was objected to for an informality. The "telephone answering machine" in claim 1 and all subsequent claims is amended to "telecommunications unit" to correct this informality.

Claims 1, 3, 6, 13, 15, 16 and 18 were rejected under 35 U.S.C. § 102 (b) as being anticipated by Hashimoto et al. This ground for rejection is overcome by the amendments to claims 1 and 13. With regard to claim 1, Hashimoto et al. do not disclose or suggest:

A telecommunications unit that records and presents audio messages which include dual-tone multi-frequency (DTMF) tones, comprising:

...a processor that stores **combined messages**, which include the received audio messages of the text representation of the DTMF tones into **the storage device.**" (emphasis added).

In Hashimoto et al., the incoming message is stored in the ICM unit 13 (col. 2, lines 66-67), while the data corresponding to the DTMF tones is stored in the memory 16. (col 3, lines 4-6). Because the subject application, as defined by claim 1, stores the incoming audio message and the text corresponding to the DTMF tones as a single combined message on a single storage device, the subject invention is not anticipated by Hashimoto et al. Basis for this amendment may be found in Figure 2 and at page 6, paragraph 24. Thus, using the subject invention, as defined by claim 1, a user does have to take extra steps to record both data entered by the telephone keypad and voice messages, such as pressing the "#" key, as required by Hashimoto et al. (see s20 in Fig. 5) nor are separate memories required to store the DTMF data and the voice message data, as required by Hashimoto et al. Because

Hashimoto et al. do not disclose or suggest the limitation of claim 1, claim 1 is not subject to rejection under 35 U.S.C. § 102 (b) as being anticipated by Hashimoto et al.

Claims 3 and 6 depend from claim 1 and are not subject to rejection under 35 U.S.C. § 102 (b) as being anticipated by Hashimoto et al. for at least the same reasons as claim 1.

Claim 13, while not identical to claim 1, includes features similar to those set forth above with regard to claim 1. Thus claim 13 is also not subject to rejection for the reasons set forth above with regard to claim 1.

Claims 15, 16 and 18 depend from claim 13 and are not subject to rejection under 35 U.S.C. § 102 (b) as being anticipated by Hashimoto et al. for at least the same reasons as claims 1 and 13.

Claims 2, 4, 5, 14, and 17 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of McNutt et al. This ground for rejection is overcome by the amendments to claims 1 and 13 described above. In particular, neither Hashimoto et al., McNutt et al., nor their combination disclose or suggest storing "**combined messages**, which include the received audio messages and the text representation of the DTMF tones into **the storage device.**" (emphasis added). Hashimoto et al. is described above. McNutt et al. disclose a message taking and retrieval system which includes a central computer, operator stations for taking telephone messages and retrieval stations for permitting retrieval of messages either locally or via a telephone call. The messages for the caller are entered using a keyboard and forwarded to the central computer. McNutt et al. do not teach storing the combined messages, including audio messages and text representations of DTMF tones, as described above. Because neither Hashimoto, McNutt, nor their combination disclose or suggest the limitations of claims 1 and 13, claims 1 and 13 are not subject to rejection under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of McNutt et al. Claims 2 and 5 depend from claim 1 and claims 14 and 17 depend from claim 13. Thus, claims 2, 5, 14 and 17 are not subject to rejection under 35 U.S.C. § 103 (a) for at least the same reasons as claims 1 and 13.

Claims 7 and 12 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Schindler et al. Hashimoto et al. is described above. Shindler et al. describe an enhanced digital video display system. It does not disclose or suggest receiving or storing DTMF tones or voice messages. Thus, Schindler et al. do not provide the material that is missing from Hashimoto et al. Accordingly, claim 1 and claims 7 and 12 which depend from claim 1 are not subject to rejection under 35 U.S.C. § 103(a) in view of Hashimoto et al. and Shindler et al. for at least the reasons set forth above with regard to claim 1. Furthermore, because Schindler does not disclose or suggest receiving or storing DTMF tones or voice messages, the only suggestion to combine Schindler et al. and Hashimoto et al. impermissibly comes from Applicant's own disclosure. It is well settled that such a suggestion must come from the prior art or from the knowledge of the skilled person.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* (emphasis added)¹

Thus, claims 7 and 12 are not subject to rejection under 35 U.S.C. § 103(a) in view of Hashimoto et al. and Shindler et al.

Claims 8, 9, 10 and 11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Schindler et al. and McNutt et al. This ground for rejection is overcome by the amendment to claim 7. Claims 8, 9, 10 and 11 depend from claim 7 and are not subject to rejection under 35 U.S.C. § 103 (a) for at least the same reasons as claim 7. Because neither Hashimoto et al., Schindler et al., McNutt et al., nor their combination disclose or suggest the limitations of claim 7 and because the only support for the combination of Hashimoto et al, Schindler et al. and McNutt et al. impermissibly comes from Applicant's own disclosure, claim 7 and claims 8, 9, 10 and 11 which depend from it are not subject to rejection under 35 U.S.C. § 103 (a) as being unpatentable over Hashimoto et al. in view of Schindler et al. and McNutt et al.

¹ MPEP §706.02(j)

Appln. No.: 10/021,426
Amendment Dated May 27, 2004
Reply to Office Action of February 27, 2004

MATP-607US

In view of the foregoing amendments and remarks, Applicants request that the Examiner reconsider and withdraw the objection to the drawing and the rejection of claims 1-18.

Respectfully submitted,



Kenneth N. Nigon, Reg. No. 31,549
Attorney(s) for Applicant(s)

KNN/tmb

Dated: May 27, 2004

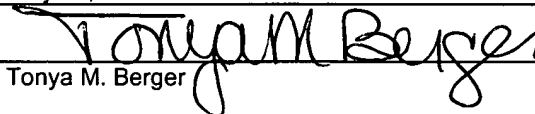
Attachments: Figure 2 (1 sheet)

P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. 18-0350 of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on:

May 27, 2004


Tonya M. Berger